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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 09/699,523)
Filing Date: October 30, 2000)
For: Random Number Generator And)
Generation Method)
Applicants: Scott A. Wilber)

Group Art Unit: 2124

Examiner: Mai, Tan V.

Docket No: 13323.101D1US
(.102) (Formerly 2022/002D1)**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that this correspondence, along with all papers referred to as being transmitted, are being facsimile transmitted to the Patent and Trademark Office Fax No. (703) 746-7239.

January 16, 2003

Date

Elaine C. Von Spreckelsen

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**BOX NON-FEE AMENDMENT
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231**

Dear Sir:

These Remarks are responsive to the Office Action mailed October 17, 2002.

REMARKS

Applicant thanks Examiner Mai for the courtesy of the interview on November 20, 2002. This response contains the substance of the items discussed in the interview.

Claims 57 – 66 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (US 4,855,690) in view of Vaughan (US 4,800,590). This rejection is respectively traversed. As admitted in the Office Action, Dias does not disclose either of a true random number generator or the computer features of the claims. However, the Office Action states that a true random number generator is "old in the art" citing Dias, column 1, lines 22 – 25 and Vaughan at FIG. 2 and column 7, lines 6 – 17. This rejection is improper. The applicant is not alleging that true random number generators are new. If it is proper to combine elements just because they exist in the prior art, then nothing would be patentable, since everything is a combination of old things. The patent law requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. MPEP 2142 and MPEP 2143.01. The Office Action does not point

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Response to Office Action Mailed 10/17/02**

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out any such suggestion or motivation from the references. Rather, the Office Action states that the motivation is that the "proposed system" is a true random number generator as claimed. We assume the "proposed system" is the combination the Office Action proposes. This proposed system is only in the Examiner's head because of the claims in front of him; thus, this statement looks to the present claims for motivation. This is hindsight and is improper. MPEP 2145X.A. Also, see *W.L. Gore & Associates, Inc. v. Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

With respect to claim 57, neither Dias nor Vaughan disclose: a) converting an analog noise signal to a binary true random sequence of signals; b) interfacing the binary true random sequence of signals to a general purpose personal computer; and c) utilizing the interfaced binary true random sequence of signals in the computer. All of the limitations of a claim must be taught by the cited references in determining the obviousness of a claim. MPEP 2143.03. Since the processes mentioned above are not in either reference, claim 57 cannot be obvious.

Further, the motivation in Dias and Vaughan is to not use a true random number generator. Dias says that true random number generators are too large. See column 1, lines 22 – 35. Dias teaches the use of the numbers in an electronic key ring, and says that in such key rings there is only a small amount of chip area, and therefore the true random number generators are not desirable in this application. *Ibid.* Vaughan uses the random signals produced by true random number generator 80 as a seed input to produce the pseudorandom number sequence to be used by the Vaughan system. See column 5, line 43 – column 6, line 32. This is believed to be due to the fact that, at the time of Vaughan, it was believed that any random sequence would be quickly pseudorandomized by inherent correlations when fed into a computer. Whatever the reason, Vaughan teaches against the use of true random numbers in computers. A patent examiner must consider the whole of the teachings of the reference and not ignore the portion of a reference that teaches against the combination according to the invention. MPEP 2145 X.D. Thus, neither Dias nor Vaughan can form a basis under 35 U.S.C. 103(a) to find claim 57 obvious.

With regard to independent claims 58 and 60 – 65, the position in the Office Action that the detail features are obvious to one of ordinary skill in the art is respectfully traversed. There is no evidence that someone skilled in the random number generator art,

prior to this disclosure, would have any familiarity with these details; thus, this contention is respectfully challenged. Moreover, what is being claimed is not just these features, but the combination with the independent claims. These combinations are not suggested anywhere in the references, so this is not a proper rejection for the reasons given above.

The Office Action does not even mention the Declaration of Scott Wilbur submitted with the previous response, which included significant objective evidence of nonobviousness. Objective evidence of nonobviousness must be considered when present and it is error to not consider it. MPEP 716.01(a). Thus, the Examiner's failure to consider this Declaration is improper.

The Examiner is invited to carefully read the application from page 1, line 8 through page 3, line 30. This discussion, which is fully supported by references provided in the IDS, shows that there was a long-felt need for the true random number generator claimed. Paragraphs 12 – 14 of the Declaration show that the invention has met that need, and is so unexpectedly superior to the prior art that the leading expert in random number generators has stated that it is the only device ever tested to pass all his randomness tests. This evidence is highly reliable because it is by a noted expert completely independent of the inventor. Further, the Declaration shows in paragraphs 15 – 26 that the invention has given rise to copying by others, which has created a new industry. Such evidence has been indicated by the Supreme Court of the United States to be highly probative of nonobviousness of this invention. MPEP 716.01(a), 716.02(a), 716.04, and 716.06.

For the above reasons, claims 57 – 66 are believed to be patentable and their reconsideration and allowance are respectfully requested. No additional fee is seen to be required. If any additional fee is required, please charge it to Deposit Account No. 50-1848.

Respectfully submitted,
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